APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,577	08/27/2001	Nobuyuki Goto	0102/0177	2735

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EXAMINER
TOPGYAL, GELEK W

ART UNIT	PAPER NUMBER
2621	

DATE MAILED: 09/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

		Application No.	Applicant(s)
Office Action Summary		09/938,577	GOTO ET AL.
		Examiner	Art Unit
		Gelek Topgyal	2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 July 2006*.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *3-5,8,11 and 12* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *3-5,8,11 and 12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *27 May 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7 July 2002 has been entered.

Claim Rejections - 35 USC § 112

2.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3.   **Claim 3** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4.   **Claim 3** recites the limitation "the specific time points" in the last paragraph of claim 3. There is insufficient antecedent basis for this limitation in the claim.

Response to Arguments

5.   Applicant's arguments with respect to claims 3-5 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

6.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7.   **Claims 3-5 and 8** are rejected under 35 U.S.C. 102(e) as being anticipated by

Vallone et al. (US 6,847,778).

Regarding claim 3, Vallone et al. teaches a program-signal recording and

reproducing apparatus for recording a program signal on a recording medium, and

reproducing an already-recorded portion of the program signal which is being recorded

on the recording medium, the apparatus comprising:

- time information generating means for generating time information in accordance

  with lapse of time (Vallone teaches in col. 22, lines 20-33 that the display

  information includes the means for generation of time);

- recording means for recording the time information generated by the time

  information generating means or time information indicating time at which the

  program signal is broadcasted on the recording medium together with the

  program signal (Vallone teaches in col. 21, lines 29-32 that the program guide

  information, which includes the broadcast time (start and stop time) and the

  current time, is recorded onto the same medium as that of the program signal);

- a head retrieval command input means for <u>sequentially</u> performing a program head retrieval ~~command~~ <u>commands</u> (Vallone teaches in col. 19, lines 23-33 a jump button 1414 and a replay button 1415 on the remote control that allows for program retrieval. The user can choose to operate the buttons multiple times, which jumps backwards or forward accordingly); and

- and first head retrieval reproduction means for, when <u>each of</u> the program head retrieval ~~command~~ <u>commands</u> is performed by the head retrieval command input means, obtaining present time information generated by the time information generating means (Vallone teaches col. 22, lines 20-33 that the display information includes the means for generation of time) and performing head retrieval reproduction of the program signal recorded at one of ~~(1) time of 00-minute or in an hour and (2) time of 30-minute in an hour which is~~ <u>specific points which are</u> previous to the present time represented by the obtained present time information, and which ~~is closer to the present time than the other is~~ <u>are after a beginning of the recording of the program signal on the recording medium and in a duration of the recorded program signal</u>; (Col. 19, lines 23-33, teaches a replay button 1415 that allows the user to jump back in time to play a section previous to the current time while in the current program is being recorded.)

- <u>wherein the specified time points are sequentially selected by the first head retrieval reproduction means in response to the program head retrieval commands in an order such that first selected one of the specified time points is closer to the present time than others of the specified time points are</u> (As recited

above, the replay button 1415 allows the user to jump back in time to play

sections previous to the current time while the current program is being recorded

(col. 19, lines 22-33). It should be understood that the user can choose to press

the replay button 1415 more than once; therefore the previous time points are

selected in a sequential manner. When the user presses the replay button 1415

for a first time, the playback point "repositions ten seconds (the time span is

system adjustable) backwards into the cache bar 2602", therefore, the specified

point is closest to the current time; e.g. ten seconds from the current time. When

the user operates the replay button 1415 twice within a short period, the playback

point should reposition to *twice* the time span as set in the system, i.e. twenty

seconds. The specified point now is twenty seconds from the current time.

Therefore, the limitation of sequentially selecting specified time points closer to

the present time is met).

Regarding claim 4, Vallone teaches a program-signal recording and reproducing

apparatus as recited in claim 3, further comprising:

- a cache playback mode in which a program signal temporally continuous from

  past to now is always recorded on a recording medium while a prescribed

  amount is a limit, and an already-recorded portion of the program signal which is

  being recorded is reproduced (Vallone teaches in col. 19, lines 27-32 that when a

  user is watching live TV, the option to play a buffered/cached portion is available

  in the same manner as an instant replay operation in sports. The instant replay is

  a cache playback equivalent);

- a time shift playback mode in which, with respect to a program signal recorded

  on the recording medium on the basis of a record start timing decided by

  operation by a user (Vallone teaches in col. 17, lines 16-25 that the user can

  instruct the system to record a particular program he or she is watching.

  Recording of a program can also be recorded by way of scheduling as described

  in col. 23, lines 10-18), and an already-recorded portion of the program signal

  which is being recorded is reproduced (Vallone teaches in col. 15, lines 14-18

  that a show either recorded (Fig. 17, elements 1702-1704 represent recorded

  shows) or currently recording (Fig. 17, element 1713 represents a program that is

  currently recording), can be viewed immediately by selecting the play button (Fig.

  18, element 1801));

- and second head retrieval reproduction means for, when the program head

  retrieval command is performed by the head retrieval command input means,

  performing head retrieval reproduction of the program signal from the record start

  timing (Vallone teaches that by selecting the play button (Fig. 18, element 1801),

  the recorded program begins playback from the head/beginning of the program);

wherein the head retrieval reproduction is performed by the first head retrieval

reproduction means in the cache playback mode (as described above in claim 3

rejection), and the head retrieval reproduction is performed by the second head retrieval

reproduction means in the time shift playback mode (as described above in claim 4).

Regarding claim 5, Vallone teaches a program-signal recording and reproducing

apparatus comprising:

- first means for recording a program signal on a recording medium (Vallone

  teaches in col. 4, lines 38-40, that the program is recorded on a medium);

- second means for generating first time information representing the present time

  (Vallone teaches in col. 22, lines 20-33 of display information which includes the

  means for generation of present time);

- third means for generating second time information representing one of (1) a time

  at which the program signal was recorded by the first means (Vallone teaches in

  col. 12, lines 36-40, that when recording a particular program, information about

  when it was recorded can be recorded onto a medium) and (2) a time at which

  the program signal was broadcasted (In col. 21, lines 29-32, Vallone describes

  that the program guide information, which includes the broadcast time (start and

  stop time), is recorded onto a medium, the same medium where the program is

  stored. Col. 22, lines 20-33 describes that the program guide information is read

  from the medium and used to generate the broadcast time);

- fourth means for determining a~~ a~~ specified time ~~point~~ points which ~~precedes~~

  precede the present time represented by the first time information generated by

  the second means, and which are after a beginning of the recording of the

  program signal on the recording medium and in a duration of the recorded

  program signal (Vallone teaches in col. 19, lines 23-33 a jump button 1414 and a

  replay button 1415 on the remote control that allows for program retrieval. The

user can choose to operate the buttons multiple times, which jumps backwards or forward accordingly. The function of the replay button 1415 can take place while the current program is being recorded);

- and fifth means for finding a segment of the program signal on the recording medium according to <u>each of</u> the specified time ~~point~~ <u>points</u> determined by the fourth means and the second time information generated by the third means, the program-signal segment relating to the second time information corresponding to the specified time point, and for reproducing the found segment and subsequent segments of the program signal from the recording medium (Vallone teaches in col. 19, lines 23-33 of a replay button 1415 that allows the user to jump back in time to play a section and the subsequent segments previous to the current time. It should be noted that the user can press the replay button 1415 more than once to sequentially jump back to playback points in increments of an adjustable time span).

- wherein the ~~specific time point corresponding to one of (1) time whose minute part is 00 and (2) time whose minute part is 30 which is closer to the present time than the other is~~ <u>specified time points are sequentially selected by the fifth means in an order such that first selected one of the specified time points is closer to the present time than others of the specified time points are</u> (As recited above, the replay button 1415 allows the user to jump back in time to play sections previous to the current time while the current program is being recorded (col. 19, lines 22-33). It should be understood that the user can choose to press the replay button

1415 more than once; therefore the previous time points are selected in a
sequential manner. When the user presses the replay button 1415 for a first time,
the playback point "repositions ten seconds (the time span is system adjustable)
backwards into the cache bar 2602", therefore, the specified point is closest to
the current time; e.g. ten seconds from the current time. When the user operates
the replay button 1415 twice within a short period, the playback point should
reposition to *twice* the time span as set in the system, i.e. twenty seconds. The
specified point now is twenty seconds from the current time. Therefore, the
limitation of sequentially selecting specified time points closer to the present time
is met).

Regarding claim 8, Vallone teaches a program-signal recording and reproducing
apparatus comprising:

- first means for recording a first program signal on a recording medium while
  leaving only a latest temporally-continuous portion of the first program signal in
  the recording medium as a cached portion (Vallone teaches in col. 5 lines 26-40
  of four DMA engines that have circular storage buffers which stores only a finite
  amount of video and data);

- second means for generating first time information representing the present time
  (In col. 22, lines 20-33, Vallone describes display information which includes the
  means for generation of present time);

- third means for generating second time information representing one of (1) a time
  at which the first program signal was recorded by the first means and (2) a time

at which the first program signal was broadcasted (In col. 21, lines 29-32, Vallone

describes that the program guide information, which includes the broadcast time

(start and stop time), is recorded onto a medium, the same medium where the

program is stored. Col. 22, lines 20-33 describes that the program guide

information is read from the medium and used to generate the broadcast time);

- fourth means for determining a specified time ~~point~~ points which ~~precedes~~

  precede the present time represented by the first time information generated by

  the second means, and which are after a beginning of the recording of the first

  program signal on the recording medium and in a duration of the recorded first

  program signal (Vallone teaches in col. 19, lines 23-33 a jump button 1414 and a

  replay button 1415 on the remote control that allows for program retrieval for

  bookmarked frames and already recorded frames, respectively, which are points

  in time prior to the current time. The user can choose to operate the buttons

  multiple times, which jumps backward or forward accordingly. The function of the

  replay button 1415 can take place while the current program is being recorded);

- fifth means for sequentially accepting ~~a~~ head-retrieval ~~command~~ commands

  (Vallone teaches in Fig. 14 of a replay button 1415 on the remote control 1401

  that a user can press multiple times. When the buttons are pressed the

  commands to jump back to another specified time point is sequentially

  processed).

- sixth means responsive to each of the head-retrieval ~~command~~ commands

  accepted by the fifth means for finding a segment of the latest temporally-

continuous portion of the first program signal on the recording medium according

to <u>one of</u> the specified time ~~point~~ <u>points</u> determined by the fourth means and the

second time information generated by the third means, the program-signal

segment relating to the second time information corresponding to <u>the one of</u> the

specified time ~~point~~ <u>points</u>, and for reproducing the found segment and

subsequent segments of the <u>first</u> program signal from the recording medium

during a cache playback mode of operation (Vallone teaches in col. 19, lines 27-

32 that when a user is watching live TV, the option to play a buffered/cached

portion is available in the same manner as an instant replay operation in sports.

The replay button 1415 displays the segment and its subsequent segments from

a previous time point. When the buttons are pressed multiple times, the previous

points are sequentially processed and therefore time points previous to the

current time can be sequentially rendered);

- seventh means for recording a second program signal on the recording medium

  in response to a designated record start timing (Vallone teaches in col. 20 lines

  23-31 that multiple tuners incorporated into the system will allow for recording of

  multiple programs); and

- eighth means responsive to <u>each of</u> the head-retrieval ~~command~~ <u>commands</u>

  accepted by the fifth means for reproducing the second program signal from the

  recording medium during a time shift playback mode of operation (Vallone

  teaches in col. 19, lines 27-32 that when a user is watching live TV, the option to

  play a buffered/cached portion is available in the same manner as an instant

replay operation in sports. The replay button 1415 displays the segment and its subsequent segments from a previous time point. The number of tuners dictate the number of programs that can be simultaneously recorded, and therefore, in the case of a two tuner system, the user could switch between two separate programs that are simultaneously recorded and therefore apply the replay button 1415 to either currently recording programs).

- wherein the ~~specific time point corresponding to one of (1) time whose minute part is 00 and (2) time whose minute part is 30 which is closer to the present time than the other is~~ specified time points are sequentially selected by the sixth means in an order such that the first selected one of the specified time points is closer to the present time than others of the specified time points are (As recited above, the replay button 1415 allows the user to jump back in time to play sections previous to the current time while the current program is being recorded (col. 19, lines 22-33). It should be understood that the user can choose to press the replay button 1415 more than once; therefore the previous time points are selected in a sequential manner. When the user presses the replay button 1415 for a first time, the playback point "repositions ten seconds (the time span is system adjustable) backwards into the cache bar 2602", therefore, the specified point is closest to the current time; e.g. ten seconds from the current time. When the user operates the replay button 1415 twice within a short period, the playback point should reposition to *twice* the time span as set in the system, i.e. twenty seconds. The specified point now is twenty seconds from the current time.

Therefore, the limitation of sequentially selecting specified time points closer to

the present time is met).

Claim Rejections - 35 USC § 103

8.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

9.   **Claim 11** is rejected under 35 U.S.C. 103(a) as being unpatentable over Vallone

et al. (US 6,847,778) in view of Tsumagari et al. (US 6,360,057).

Regarding claim 11, Vallone et al. teaches all the limitations as recited in claim

3 above, but fails to particularly teach wherein each of the specified time points has a

minute part of (1) 00 and (2) 30.

In an analogous art, Tsumagari teaches in col. 29, line 49 through col. 29, line 47

of a system that is capable of recording entry points according to a user selectable

interval. Therefore, a user can set a time interval of "an"= 30 minutes, which thereby

records entry points every thirty minutes. Therefore a program recording starts at the

00th minute, and every successive 30th minute during the recording process is tagged

with an entry point. Tsumagari teaches in col. 31, lines 34-59 of the ability for the user to

select a created entry point, i.e. every thirty minutes, and therefore the video from the

selected entry point is played back.

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to incorporate the ability to jump back to play a previous portion of

a recorded program at entry points that have been created every thirty minutes as

taught by Tsumagari et al. into the system of Vallone et al. because it allows the user

the ability to reproduce recorded portions of a video program at any desired location.

10.   **Claim 12** is rejected under 35 U.S.C. 103(a) as being unpatentable over Vallone

et al. (US 6,847,778) in view of Geer et al. (US 6,778,882).

Regarding claim 12, Vallone et al. teaches all the limitations as recited in claim

3 above, but fails to particularly teach wherein the first head retrieval reproduction

means comprises means for performing head retrieval reproduction of the program

signal from the beginning of the recording of the program signal when none of the

specified time points are usable as effective ones.

In an analogous art, Geer et al. teaches a simultaneous recording and playback

apparatus that during automatic recording of selected channels, a user has the option to

start viewing the program at the beginning of the program before the recording has

completed by using buttons 1430 an 1450 to select a desired program and then

pressing button 1410 to commence the reproduction. (Fig. 9, Fig. 14, elements 1420,

1430, 1450, and col. 8, line 1 – col. 9, line 43)

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to incorporate the start of program retrieval as taught by Geer into

Vallone's recording apparatus because it allows a user an easy and convenient way to reproduce recorded portions of a video program at any desired location.
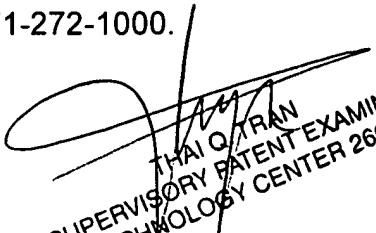
Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The cited reference teaches a system that allows sequential reproduction using indexed points within a video program.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gelek Topgyal whose telephone number is 571-272-8891. The examiner can normally be reached on 8:30am -5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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